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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,678	02/25/2002	Stewart L. Atkinson	092246-9035-03	8406
23409	7590	03/01/2005		
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			EXAMINER WILLSE, DAVID H	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 03/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/082,678	Applicant(s) ATKINSON ET AL.	
	Examiner Dave Willse	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 14-24, 26, 27 and 112-125 is/are pending in the application.
- 4a) Of the above claim(s) 115-119, 121 and 123-125 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 14-24, 26, 27, 112-114, 120 and 122 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/17/04; 9/20/04 (3 sheets)</u> | 6) <input type="checkbox"/> Other: _____ |

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In the Information Disclosure Statement of May 17, 2004, certain references were *not* considered because a concise explanation of the relevance (37 C.F.R. § 1.98(a)(3)) or a complete copy (37 C.F.R. § 1.98(a)(2)) was not presented.

The Applicant asserts that claims 115-119, 121, and 123-125 are readable on elected species VIII but fails to offer any evidence that the embodiment of Figures 14-19 includes a limit strap; therefore, these claims are withdrawn from consideration (37 CFR 1.142(b)) as being drawn to a non-elected species.

Claims 17-24 and 27 are deemed to have an effective filing date of February 25, 2002, because at least one limitation in each said claim is not supported in great-grandparent U.S. application serial no. 08/602,241, now U.S. patent no. 5,800,568.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pusch, US 6,077,301, which discloses a pylon (including adaptor 30), a prosthetic foot 10 and 11, a prosthetic ankle 20, and a limiting means (comprising elements 90-93 and 34). Regarding claim 19: column 4, lines 22-24; Figure 1. Regarding claim 21, the ankle 20 “may be made from a

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carbon composite" (column 4, line 53), and the pyramidal adaptor **30** is inherently of a more rigid material because of its intended function as an adjustable connector to upper portions of the leg prosthesis.

Claims 22-24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pusch, US 6,077,301. Regarding claim 22, prosthetic leg members of carbon-fiber composites were well known in the art and would have been obvious in view of their low weight and adequate strength, with the ordinary practitioner having been left to select an appropriate material; fiberglass materials were likewise commonly used for ankle and foot members and would have been an obvious alternative to a carbon composite in order to provide amputees with a broader range of choices for dynamic response characteristics. Regarding claims 23 and 24, split foot prostheses were well known in the art and would have been obvious from their disclosed advantages pertaining to improved gait performance, adaptability to rough terrain, etc. Regarding claim 27 and others, an adjustment screw would have been obvious from column 3, lines 42-45.

Claims 1-4, 6, 14-21, 112, and 114 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Carter, US 2,453,969. The embodiment of Figures 1-3, for example, comprises a pylon **1** and **2**; a prosthetic foot **22**; a prosthetic ankle **5**, **6**, **9**, and **18**; and a limiting means **26** and **29**. Because of the engagement between the snubber finger **12** and the snubber keeper **29** (column 3, lines 9-14 and 53-69), the limiting means is coupled to at least one of the lower end of the pylon and the upper leg **9** at least during a portion of a gait cycle. The embodiment of Figures 4-6 likewise possesses all of the elements of instant claim 1 and others.

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Claims 22-24, 26, 27, 113, 120, and 122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter, US 2,453,969. The further limitations of claim 22 would have been an obvious upgrade of materials for reasons cited above. Regarding claims 23 and 24, the prosthetic foot **22** being split at the toe portion into lateral and medial sections, a well known feature of the art, would have been obvious in order to further accommodate "sidewise movement between said calf portion and said foot portion" (column 3, lines 19-21). Regarding claims 26, 27, and 120, tightening the screws or bolts **50** inherently adjusts the position of the snubber keeper **55** relative to the snubber finger **54**; moreover, providing an adjustment means would have been obvious in order to modify the gait dynamics associated with the function described at column 3, lines 66-69, so as to match the needs of a particular amputee.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees (*In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969)).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application (37 CFR 1.130(b)).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6, 14-22, 26, 112-114, 120, and 122 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,800,568. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present features appear in, are inherent from, or would have been obvious from the patent claim. The further limitations of claims 2, 3, 112, and 113 would have

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been inherent from column 6, lines 1-6 (of patent claim 1). The further limitations of claims 17, 18, 20, and 21 would have been obvious from the function of the interconnecting member (as set forth in patent claim 1) and from the fact that many prosthetic pylons have a circular cylindrical form. Claim 22 would have been obvious for reasons presented above.

Claims 1-4, 6, 14-22, 112, and 114 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,350,286 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant limitations are found in or would have been obvious from the claims of the patent, for reasons similar to those given above.

The added rejections were necessitated by the broadening of the claims in at least some respects, such as the “link” features being replaced by “means for limiting” (claim 1, line 11) or “limit device” (claim 114, line 11). Therefore:


All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (571) 272-4762. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


Dave Willse
Primary Examiner
Art Unit 3738